

### RESPONSE AND REMARKS

The above listing of claims recites amendments to Claims 1, 4, 6, 8, 9 and 10 previously presented to more distinctly claim the claimed invention. Reconsideration of the application, as previously presented, and an Advisory Action, are respectfully requested in view of the following remarks.

#### SECTION 103

In the Final Office Action, the Examiner rejected Claims 1-10 under 35 U.S.C. 103(a) as being unpatentable over Boone et al. (U.S. Patent No. 6,311,240; "Boone") and Andric et al. (U.S. Patent No. 5,449,200; "Andric") in view of Irons (U.S. Patent No. 6,192,165; "Irons").

With respect to Claims 1, 3, 4, and 6-10, the Examiner stated that:

Boone substantially discloses a system/method for assisting formatted data transfer that allows a formatting storage controller to read and record data on a formatted storage medium (which is readable as Applicant's claimed invention wherein said a method for selecting a media type format for which to generate value-bearing item indicia), said method comprising: Receiving an input; and identifying a media type format (see., abstract, col 4, lines 13-31, col 5, lines 12-38, specifically wherein said the formatting storage controller may select by reference a number of on-media structure definition.

#### Final Office Action, Topic Number 4, page 2.

In the Final Office Action, the Examiner conceded that "Boone fails to explicitly disclose the step of securing paper control number." However, in support of the Section 103(a) rejection of Claims 1, 3, 4, and 6-10, the Examiner stated that:

Andric discloses a security paper for incorporation in a security document, or other document having intrinsic value. . . . It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the formatted data of Boone by including the limitation detailed above as taught by Andric because this would verify the authenticity of the documents or papers.

#### Final Office Action, Topic Number 4, page 3.

In the Final Office Action, the Examiner conceded that "Boone and Andric fail to disclose Applicant's newly added limitation wherein said secured paper control number comprises a serial number that uniquely corresponds to a particular unit." However, in support of the Section 103(a) rejection of Claims 1, 3, 4, and 6-10, the Examiner stated that:

Irons discloses a system and method for indexing, imaging, storing, and retrieving paper-based documents. Wherein each paper-based documents has a unique serial number associated with it or each document number will be globally unique or security code (see., abstract, col 11, lines 27-67, col 12, lines 1-17). Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Boone and Andric by including the limitation detailed above as taught by Irons because this would allow users to index and label documents prior to scanning/formatting documents of papers.

Final Office Action, Topic Number 4, page 3.

With respect to Claims 2 and 5, the Examiner stated in the Final Office Action that:

Boone substantially discloses a system/method for assisting formatted data transfer that allows a formatting storage controller to read and record data on a formatted storage medium (which is readable as Applicant's claimed invention wherein said a method for selecting a media type format for which to generate value-bearing item indicia), said method comprising: Receiving an input; and identifying a media type format (see., abstract, col 4, lines 13-31, col 5, lines 12-38, specifically wherein said the formatting storage controller may select by reference a number of on-media structure definition.

Final Office Action, Topic Number 4, pages 3-4.

The Examiner conceded that "Boone fails to explicitly disclose the step of securing paper control number." However, in support of the rejection of Claims 2 and 5, the Examiner stated that:

Andric discloses a security paper for incorporation in a security document, or other document having intrinsic value. . . . It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the formatted data of Boone by including the limitation detailed above as taught by Andric because this would verify the authenticity of the documents or papers.

The rejections by the Examiner have been carefully considered. Claims 1, 4, 6, 8, 9 and 10 have been previously amended to more distinctly claim the claimed invention. The remainder of the claims remain in the application, unamended. Reconsideration of the application, as previously presented, is respectfully requested in view of the following remarks.

Applicant respectfully disagrees with the conclusion of the Examiner that "it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Boone and Andric by including the limitation detailed above as taught by Irons because this would allow users to index and label documents prior to scanning/formatting documents of papers."

It is respectfully submitted that the claims of the present application are patentably distinct from the disclosures of Boone, Andric, or Irons, whether considered alone or in combination with each other or with any other reference of record, because the claims of the present application are directed to identifying, retrieving or recording, as the case may be, an indication of media type on which value-bearing items are to be printed.

As the present application explains, "[m]edia type is the type of physical media on which something . . . is to be printed." Specification, page 2, lines 16-17. As the present application further explains:

One way that media type selection is identified to a system is by selecting from a list of available media types supported by the particular system. Sometimes, lists of available media types are identified with graphic icons and/or text. Once a user has identified to a system a particular media type on which to print, the system, e.g. the generic VBI system, can then generate the information to be printed, e.g., generic VBI indicia, in a format corresponding to the particular media type selected.

Specification, page 3, lines 6-12.

Further, as the present application explains, the problem of obtaining an indication from a user as to the media type on which material is to be printed is evolving:

As manufacturers make new media types on which to print information such as VBI, or generic VBI indicia, a system for printing such information, e.g., a generic VBI system, will need to add each new form factor to the respective user interface media type selection feature. As more and more

manufacturers make media types on which to print generic VBI indicia, the list of available and supported form factors/media types will become increasingly longer.

Specification, page 3, lines 15-20.

It is respectfully submitted that none of Boone, Andric, or Irons, whether considered alone or in combination with each other or with any other reference of record even disclose the problem addressed by the present claimed invention, much less disclose the elements of the claimed invention or provide any motivation for solving the problem to which the present claims are directed.

Irons discloses generation (see Irons, col. 12 at lines 18-54) of a label (for example, element 500 in FIG. 5, as described in Irons, col. 11 at lines 26-59). As disclosed by Irons, the label is "subsequently applied to the document by the user or by desktop labeling mechanism 202." Irons, col. 12 at lines 48-49. The label includes a "software serial number field 510 . . .". Irons, col. 11 at lines 32-33. The Irons software serial number field 510 "is used to identify a unique customer." Irons, col. 11 at lines 35-36. The label also includes a "computer readable portion 420" that "is decoded by the scanning subsystem . . .". See, Irons, col. 11 at lines 7-8; Irons, col. 12 at lines 60-63. "...[L]abel 500 includes a unique document number, which becomes the image file name after the document is scanned."

It is respectfully submitted that the Irons disclosure of a unique document number or of a unique customer number is not a disclosure of an association between a secured paper control number and a media type of the secured paper. Further, it is respectfully submitted that there is no disclosure in Irons that an Irons label contains any indication of a media type of a document on which an Irons label is to be applied or from which an Irons label is scanned.

Boone discloses "an on-media structure select field in the command block 214. The on-media structure select instructs the formatting storage controller 206 which on-media structure definition to use from the persistent storage unit 228. . . . The formatting storage controller 206 receives the command block 214, reads the on-media structure selector, and selects the corresponding on-media structure definition from the persistent storage unit 228 for use during data

transfer, thereby alleviating the requirement that the host provide a detailed on-media structure definition in the command block 214." Boone, col. 5, lines 15 - 31.

As compared to an "on-media structure select instruct[ing a] formatting storage controller [as to] which on-media structure definition to use . . ." as disclosed in Boone, the present claimed invention is directed to receiving from a user, or identifying or retrieving an indication of, media type on which value-bearing items are to be printed.

Andric is directed to ensuring authenticity of secured paper. As compared to Andric, the claims of the present application are not directed to verifying or ensuring the authenticity of secured documents or papers. Rather, the claims of the present application are directed to identifying, retrieving, or recording an indication of media type on which value-bearing items are to be printed.

The present application explains limitations of previously available approaches to solving the problem that is the subject matter of the present claims:

Some VBI systems, such as computer-based generic VBI systems, use graphic icons and/or text to identify each media type available and supported by the particular system. A list of available and supported media types/form factors may be presented, for example, in a pull-down menu. As will be understood by someone with ordinary skill in the art, a pull-down menu on any particular user interface display screen is limited in space. As the list of available and supported form factors becomes increasingly longer, some VBI systems decrease the size of displayed graphic icons and/or text in order to accommodate the limited display space of online user interface displays. The smaller the graphic icon and/or the shorter the descriptive text, and the longer the list of available media type options, the more confusing, inconvenient, and/or time-consuming it can be for a user to identify and select the appropriate media type/form factor from the list.

Specification, page 3, line 21 through page 4, line 2.

It is respectfully submitted that relating "a secured paper control number" "uniquely . . . to a particular unit of secured paper stock" and to "a media type format", as claimed, for example, in amended Claim 1, is a patentably distinct

relationship claimed by the present application directed to solve a problem that was not even disclosed in the prior art, and as such, is not itself disclosed, suggested, or anticipated by the prior art. It is respectfully submitted that an obviousness rejection under 35 U.S.C. § 103 (a) based on hindsight gleaned from the present application, as compared to the prior art, would not be properly based.

It is respectfully submitted that none of Boone, Andric, or Irons, whether considered alone or in combination with each other or with any other reference of record discloses, anticipates or suggests, as claimed by independent Claim 1, as amended, "[a] method for selecting a media type format . . . . comprising: receiving from a user an input of a secured paper control number, wherein said secured paper control number comprises a serial number that uniquely corresponds to a particular unit of secured paper stock. . ." and "identifying a media type format corresponding to the secured paper control number." In particular, there is no disclosure in Boone, Andric, or Irons, of any " . . . control number compris[ing] a serial number that uniquely corresponds to a particular unit of secured paper stock . . . " and to "identifying a media type format corresponding to the secured paper control number."

Further, it is respectfully submitted that none of Boone, Andric, or Irons, whether considered alone or in combination with each other or with any other reference of record discloses, anticipates or suggests, as claimed by independent Claim 4, as amended, "[a] method for determining a media type for a particular unit of secured paper ... comprising: receiving from a user an input of a serial number, wherein the serial number is displayed on the particular unit of secured paper and wherein the serial number uniquely identifies the particular unit of secured paper. . ." and "retrieving from a memory storage a record corresponding to the serial number, wherein said record defines a media type format corresponding to the serial number." In particular, there is no disclosure in Boone, Andric, or Irons of a "... serial number, wherein said record defines a media type format corresponding to the serial number."

Yet further, it is respectfully submitted that none of Boone, Andric, or Irons, whether considered alone or in combination with each other or with any other reference of record discloses, anticipates or suggests, as claimed by independent Claim 8, as amended, "[a] method for identifying to a system a secured paper media type. . . comprising: displaying on a particular unit of secured paper a unique secured paper identifier wherein the particular unit of secured paper corresponds to a particular media type . . ." In particular, there is no disclosure in Boone, Andric, or Irons of ". . . a unique secured paper identifier wherein the particular unit of secured paper corresponds to a particular media type . . ."

For the foregoing reasons, it is respectfully submitted that because none of Boone, Andric, or Irons, whether considered alone or in combination with each other or with any other reference of record discloses, anticipates or suggests the subject matter of independent Claims 1, 4 and 8, as amended, of the present application, those claims are patentable over the cited references. Further, it is respectfully submitted that Claims 2-3, 5-7 and 9-10, which are dependent on independent Claims 1, 4 and 8 respectively, are therefore also patentable over the cited references.

#### CONCLUSION

In view of the foregoing reasons, it is respectfully submitted that the invention disclosed and claimed in the present application is not fairly taught by any of the references of record, taken either alone or in combination, and that the

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application is in condition for allowance. Accordingly, it is respectfully requested that the present application be reconsidered and allowed.

Respectfully submitted,

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